

### **REMARKS**

Claims 1-24 and 26-28 are pending in the application. Claims 1, 13 and 16 have been amended. Claim 25 has been canceled. Claim 13 has been amended to include a limitation of claims 11 and 16, consequently, no additional search is necessary, and the amendment should be entered.

#### **Specification**

The Patent Office objected to the Abstract of the Disclosure.

The Abstract has been amended.

#### **Claim Rejections – 35 U.S.C. § 112**

The Patent Office rejected claims 1-6 and 28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to more particularly point out and distinctly claim the subject matter which applicant regards as the invention, consequently, claims 1-6 and 28 are believed definite.

#### **Claim Rejections – 35 U.S.C. § 103(a)**

The Patent Office rejected claims 1, 2-4, 7-10, 13-23, and 28 under 35 U.S.C. 103(a) as being unpatentable over Cluts, U.S. Patent No. 5,616,876 ("Cluts"), and the article entitled Jukeboxes, published by PC Magazine in 1999 ("PC Magazine").

Applicant respectfully traverses. Applicant respectfully submits that claims 1, 7, 13 and 22 include novel and nonobvious elements. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Independent claims 1, 7, 13 and 22 include elements that have not been disclosed, taught, or suggested by the combination of Cluts and PC Magazine. For instance, Cluts and PC Magazine do not disclose, teach or suggest means for receiving a criteria set including at least one user-defined classification. (Emphasis Added). Cluts discloses selecting individual songs or predetermined collections of music. For instance, Clutz states, "The subscriber may also select playlists, which are predetermined collections of songs." (Clutz, Col. 4, Lines 46-48). PC Magazine discloses a similar method of song selection, wherein a user may select songs by up to three general pre-determined classes, such as artist, tempo, genre, mood or situation. Pre-determined playlists or categories are well known in the art. An advantageous aspect of the present invention is a criteria set of desired media content including at least one non-predetermined, user-defined classification for at least one piece of media content. (Emphasis added). This limitation is not taught, suggested or disclosed in either Cluts or PC Magazine. Consequently, under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claims 1, 7, 13 and 22. Claims 2-6, 8-12, 14-21 and 23-28 are believed allowable due to their dependence upon an allowable base claim.

Additionally, claim 13 recites means for receiving a criteria set includes information from at least one physiological input, including a heart rate monitor and motion detector. Applicant respectfully submits obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The Examiner is correct in asserting that Picard teaches a wearable computer can learn to recognize physical and physiological patterns. However, neither Cluts, PC Magazine, nor Picard teach, disclose or suggest receiving means of a content assembling system including information from at least one physiological factor. Consequently,

Cluts/PCMagazine fail to provide motivation to combine the Picard reference. As a result, claim 13 includes novel and non-obvious elements that have not been taught or suggested by the prior art.

**Claim Rejections – 35 U.S.C. § 103(a)**

The Patent Office rejected claims 5, 6, 11, 12, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Cluts/PC Magazine and R.W. Picard (Article entitled Affective Wearables) ("Picard").

The Patent Office rejected claims 5, 6, 11, 12 and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Cluts and Picard.

Applicant respectfully traverses the rejection of claims 5, 6, 11, 12, 24-27 Since claims 3, 5, 6, depend from claim 1, claims 11, and 12 depend from claim 7, and claims 24-27 depend from claim 22, claims 5, 6, 11, 12, 24-27 are believed allowable.

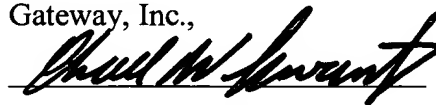
**CONCLUSION**

The application is respectfully submitted to be in condition for allowance. Accordingly, notification to that effect is earnestly solicited. In the event that issues arise in the application that may readily be resolved via telephone, the Examiner is kindly invited to contact the undersigned Attorney at (402) 496-0300.

Respectfully submitted,

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